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Attorneys for Defendants and Counterclaim Plaintiffs

Marc Jacobs International, LLC,

Saks Incorporated, d/b/a Saks Fifth Avenue, and

Neiman Marcus Group Limited, LLC

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

NIRVANA, L.L.C.,

Plaintiff,

v.

MARC JACOBS INTERNATIONAL
L.L.C., et al.,

Defendants.

MARC JACOBS INTERNATIONAL
L.L.C., et al.,

Counterclaim Plaintiffs,

v.

NIRVANA, L.L.C.,

Counterclaim Defendant.

Case No.: 2:18-cv-10743-JAK-SK

**DECLARATION OF MICHAEL J.
ZINNA IN SUPPORT OF
DEFENDANTS AND
COUNTERCLAIM PLAINTIFFS'
MOTION FOR SUMMARY
JUDGMENT**

Honorable John A. Kronstadt

Hearing Date: April 5, 2021

Hearing Time: 8:30 a.m.

Courtroom: 10B

1 I, Michael J. Zinna, declare as follows:

2 1. I am an attorney admitted to practice before the courts of the State of
3 New Jersey and this Court, and am a partner at Kelley Drye & Warren, one of the
4 counsel of record for Defendants and Counterclaim Plaintiffs Marc Jacobs
5 International, LLC (“MJ”) and Saks Incorporated d/b/a Saks Fifth Avenue
6 (“Saks”) (together “Defendants”).

7 2. I submit this declaration (the “Declaration” or “Zinna Declaration”) in
8 support of the Defendants Motion for Summary Judgment (the “Motion”).

9 3. I have personal knowledge of the following facts and if called upon as
10 a witness, I could and would competently testify thereto.

11 4. Pursuant to Local Rule 7-3, Defendants met and conferred with
12 Nirvana, LLC (“Nirvana” or the “Plaintiff”) (together with Defendants, the
13 “Parties”) on October 28, 2020.

14 **Deposition Transcripts**

15 5. Attached as **Exhibit 1** is a true and correct copy of the relevant
16 excerpts of the final transcript of the deposition of David E. Grohl taken September
17 10, 2019. This deposition was not designated confidential.

18 6. Attached as **Exhibit 2** is a true and correct copy of the relevant
19 excerpts of the final transcript of the deposition of Krist A. Novoselic taken
20 September 10, 2019. This deposition was not designated confidential.

21 7. Attached as **Exhibit 3** is a true and correct copy of the relevant
22 excerpts of the final transcript of the deposition of Robert A. Fisher taken August
23 27, 2020. This deposition was not designated confidential.

24 8. Attached as **Exhibit 4** is a true and correct copy of the relevant
25 excerpts of the final transcript of the deposition of Allen Draher taken March 5,
26 2020. This deposition was not designated confidential.

1 9. Attached as **Exhibit 5** is a true and correct copy of the relevant
 2 excerpts of the final transcript of the deposition of Lee Johnson taken March 6,
 3 2020. This deposition was not designated confidential.

4 10. Attached as **Exhibit 6** is a true and correct copy of the relevant
 5 excerpts of the final transcript of the deposition of Live Nation 30(b)(6) witness,
 6 by designee Cecil Bryan, taken August 13, 2020. This deposition was not
 7 designated confidential.

8 11. Attached as **Exhibit 7** is a true and correct copy of the relevant
 9 excerpts of the final transcript of the deposition of Plaintiff 30(b)(6) witness, by
 10 designee John P. Silva, together with Exhibit 5 introduced at the deposition taken
 11 August 18, 2020. This deposition was not designated confidential.

12 12. Attached as **Exhibit 8** is a true and correct copy of the relevant
 13 excerpts of the final transcript of the deposition of John P. Silva taken August 19,
 14 2020. This deposition was not designated confidential.

15 13. Attached as **Exhibit 9** is a true and correct copy of the relevant
 16 excerpts of the final transcript of the deposition of Mark Kates taken September 4,
 17 2020. This deposition was not designated confidential.

18 14. Attached as **Exhibit 10** is a true and correct copy of the relevant
 19 excerpts of the final transcript of the deposition of Robin Sloane Seibert taken
 20 September 4, 2020. This deposition was not designated confidential.

21 15. Attached as **Exhibit 11** is a true and correct copy of the relevant
 22 excerpts of the final transcript of the deposition of Marc Jacobs taken February 25,
 23 2020. This deposition was designated confidential.

24 **Expert Declaration and Report & Non-Party Witness Declarations**

25 16. Attached hereto as **Exhibit 12** is a true and correct copy of the Expert
 26 Report of Sarah Butler dated September 8, 2020 produced by Defendants and
 27 Counterclaim Plaintiffs in this action.

1 17. Attached as **Exhibit 13** is a true and correct copy of the Declaration
2 obtained from Rosemary Carroll. The declaration was signed on August 28, 2020.

3 **Documents Produced By Plaintiff**

4 18. Attached as **Exhibit 14** are true and correct copies of documents
5 produced by Plaintiff Bates numbered, NIRVANA 001297-1354, which are
6 screenshots of Plaintiff's webpage, Nirvana.com, listing various products for sale
7 bearing the Disputed Smiley, and specifically the t-shirt pictured in the Complaint.

8 19. Attached as **Exhibit 15** are true and correct copies of documents
9 produced by Plaintiff Bates numbered, NIRVANA 001501-49, which contains
10 advertising for shirts bearing the Disputed Smiley adjacent to the term NIRVANA.

11 20. Attached as **Exhibit 16** are true and correct copies of documents
12 produced by Plaintiff Bates numbered, NIRVANA 001673-78, which are emails
13 between Robert Fisher and Michael Meisel, Plaintiff's representative.

14 21. Attached as **Exhibit 17** are true and correct copies of documents
15 produced by Plaintiff, specifically documents Bates numbered, NIRVANA
16 111046-54, which are marketing materials for a collaboration between Nirvana and
17 Stance for socks in Spring 2020.

18 **Documents Produced By Defendants and Counterclaim Plaintiffs**

19 22. Attached as **Exhibit 18** are true and correct copies of documents
20 produced by MJI, specifically document Bates numbered, MJI- Nirvana 000090-
21 102; 115-17; 122; 475, which are pictures of product designs produced and used by
22 MJI which bear smiley face designs on numerous products.

23 23. Attached as **Exhibit 19** are true and correct copies of documents
24 produced by MJI, specifically document Bates numbered, MJI-Nirvana 000121,
25 which is an image of a shirt previously produced and used by MJI which bears the
26 word Heaven.

1 24. Attached as **Exhibit 20** are true and correct copies of documents
 2 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 000226,
 3 which are marketing images for the Redux Grunge Collection for digital channels.

4 25. Attached as **Exhibit 21** are true and correct copies of documents
 5 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 000360-72,
 6 which is the Redux Grunge Collection lookbook.

7 26. Attached as **Exhibit 22** are true and correct copies of documents
 8 produced by MJJ, specifically document Bates numbered, MJJ- Nirvana 000414-
 9 15, 417-23, 1912-25, 1930-33, 1936-37, 2897-2900, 3179-82, 3186, 408-410, 429-
 10 430, 416, 411-13, 425-427, 1926-28, 1934-35, 2889-95, 3176-78, 3183-85, 3186,
 11 which are screenshots of publicly available webpages in which a product, which
 12 was at one point or is currently for sale, contains a smiley face.

13 27. Attached as **Exhibit 23** are true and correct copies of documents
 14 produced by MJJ, specifically document Bates numbered, MJJ- Nirvana 001049-
 15 51, which are images from the installation of the Redux Grunge Collection at
 16 Dover Street Market Los Angeles, California.

17 28. Attached as **Exhibit 24** are true and correct copies of documents
 18 produced by MJJ, specifically document Bates numbered, MJJ- Nirvana 001112-
 19 42, which is a sales guide containing the twenty six looks, each item within, and
 20 ready to wear additions of the Marc Jacobs Redux Grunge Collection.

21 29. Attached as **Exhibit 25** are true and correct copies of documents
 22 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 001290-
 23 317, which is a digital lookbook for the Marc Jacobs Redux Grunge Collection.

24 30. Attached as **Exhibit 26** are true and correct copies of documents
 25 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 001318-20,
 26 1327-30, which are articles from Women's Wear Daily (WWD) and Vogue
 27 regarding the launch of the Marc Jacobs Redux Grunge Collection.

1 31. Attached as **Exhibit 27** are true and correct copies of documents
2 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 001486,
3 1488, which is a cover of Elle Magazine featuring Lady Gaga in the Marc Jacobs
4 Redux Grunge Collection and correspondence regarding same.

5 32. Attached as **Exhibit 28** are true and correct copies of documents
6 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 000222-23,
7 showing the advertising and marketing channels for the Marc Jacobs Redux
8 Grunge Collection.

9 33. Attached as **Exhibit 29** are true and correct copies of documents
10 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 002901-03,
11 which are images of the shirt that is one of the Accused Products, also pictured in
12 the Complaint, and its hangtag.

13 34. Attached as **Exhibit 30** are true and correct copies of documents
14 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 002923,
15 which is an internal MJJ email which discusses the installations of the Redux
16 Grunge Collection at stores: Dover Street Market Los Angeles, Bergdorf
17 Goodman New York, Saks New York, and Corso Como New York.

18 35. Attached as **Exhibit 31** are true and correct copies of documents
19 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 003007-09,
20 which is the flyer for a mini-clinic at Bergdorf Goodman to educate the store
21 personnel on the history, meaning, and details of the collection.

22 36. Attached as **Exhibit 32** are true and correct copies of documents
23 produced by MJJ, specifically document Bates numbered, MJJ-Nirvana 003077-90,
24 which is the Redux Grunge Styling Guide for SSENSE.

25 37. This paragraph is left intentionally blank.

26 38. Attached as **Exhibit 34** are true and correct copies of documents
27 produced by SAKS, specifically document Bates numbered, Saks-Nirvana 000058-
28

59, which are images from the installation of the Redux Grunge Collection at Saks Fifth Avenue.

Documents Produced By Third Parties Under Subpoena

39. Attached as **Exhibit 35** are true and correct copies of documents produced by Robert Fisher, specifically document Exhibit numbered, Exhibit A to J, which relate to Mr. Fisher's creation and authorship of the Disputed Smiley and the Registered Work and his communications with Plaintiff regarding such.

Captures of Publicly Available Websites

40. Attached hereto as **Exhibit 36** are true and correct copies of printouts from publicly available websites offering for sale clothing and apparel bearing smiley face designs similar or nearly identical to the Disputed Smiley by numerous third parties collected by employees of my firm under my direction and supervision.

41. Attached hereto as **Exhibit 37** are true and correct copies of printouts from publicly available websites offering for sale Nirvana clothing bearing the Disputed Smiley by numerous retailers, including: H&M, Hot Topic, Kohl's, Target, and Walmart, collected by employees of my firm under my direction and supervision..

42. Attached hereto as **Exhibit 38** are true and correct copies of printouts from the publicly available website, Nirvana.com, offering for sale various clothing items bearing the Disputed Smiley, collected by employees of my firm under my direction and supervision..

43. Attached hereto as **Exhibit 39** is true and correct copy of a printout from the publicly available website, Nirvana.com, offering for sale a hoodie sweatshirt bearing the Disputed Smiley for \$44.99, collected by employees of my firm under my direction and supervision..

1 44. Attached hereto as **Exhibit 40** are true and correct copies of printouts
 2 from the publicly available website, Stance.com, offering for sale Nirvana socks
 3 bearing the Disputed Smiley, for \$12.99, collected by employees of my firm under
 4 my direction and supervision..

5 45. Attached hereto as **Exhibit 41** are true and correct copies of a publicly
 6 available press release and product page of Stance socks, collected by employees
 7 of my firm under my direction and supervision.

8 46. Attached hereto as **Exhibit 42** are true and correct copy of a printout
 9 from the MJI website showing the offering for sale of its Heaven collection.

10 47. Attached hereto as **Exhibit 43** are true and correct copy of a printout
 11 from dictionary.com showing the definition of the term Nirvana.

12 **Captures of Publicly Available Government Database Records**

13 48. Attached hereto as **Exhibit 44** is a true and correct copy of the
 14 trademark application for the Disputed Smiley, U.S. Ser. App. No. 88/279,690
 15 dated Jan. 28, 2019, obtained from the publicly available Trademark Status &
 16 Document Retrieval (TSDR) database of the United States Patent and Trademark
 17 Office.

18 49. Attached hereto as **Exhibit 45** is a true and correct copy of the Notice
 19 of Opposition to the registration of U.S. Application Ser. No. 88/279,690 MJI filed
 20 with the Trademark Trial and Appeal Board on September 2, 2020.

21 **Plaintiff's Discovery Responses**

22 50. Attached as **Exhibit 46** is a true and correct copy of Plaintiff's
 23 Responses to Defendants First Requests for Admission (Nos. 1-14), dated July 12,
 24 2019.

25 51. Attached as **Exhibit 47** is a true and correct copy of Plaintiff's
 26 Responses to Defendants First Requests for Production (Nos. 1-6), dated July 12,
 27 2019.

1 52. Attached as **Exhibit 48** is a true and correct copy of Plaintiff's
2 Responses to Defendants First Set of Interrogatories (Nos. 1-4), dated July 12,
3 2019.

4 53. Attached as **Exhibit 49** is a true and correct copy of Plaintiff's
5 Supplemental Responses to Defendants First Requests for Production (Nos. 1-6),
6 dated October 14, 2019.

7 54. Attached as **Exhibit 50** is a true and correct copy of Plaintiff's
8 Supplemental Responses to Defendants First Set of Interrogatories (Nos. 1, 3),
9 dated November 7, 2019.

10 55. Attached as **Exhibit 51** is a true and correct copy of Plaintiff's
11 Responses to Defendants' Second Set of Requests for Production of Documents
12 (Nos. 1-140), dated December 23, 2019.

13 56. Attached as **Exhibit 52** is a true and correct copy of Plaintiff's
14 Responses to Defendants' Second Set of Requests for Admission (Nos. 15-20),
15 dated January 6, 2020.

16 57. I have overseen the review and production of documents in this matter
17 and have reviewed or overseen the review of all documents produced by Plaintiff
18 Nirvana, LLC ("Nirvana" or "Plaintiff") up until the close of discovery.

19 58. Documents with Bates numbering beginning with the prefix
20 "Nirvana" were produced by Plaintiff. Documents with Bates numbering
21 beginning with the prefix "MJi-Nirvana" were produced by Defendant and
22 Counterclaim Plaintiff MJi. Documents with Bates numbering beginning with the
23 prefix "Saks-Nirvana" were produced by Defendant and Counterclaim Plaintiff
24 Saks. Documents with Bates numbering beginning with the prefix "Neiman
25 Marcus-Nirvana" were produced by Defendant and Counterclaim Plaintiff Neiman
26 Marcus Group Limited, LLC ("Neiman Marcus").

1 59. During discovery, Defendants and Counterclaim Plaintiffs MJJ, Saks,
2 and Neiman Marcus requested documents and information relating to the
3 allegations in Plaintiff's Complaint, including:

4 i. Efforts to obtain, secure, and/or maintain registration of the
5 Disputed Smiley in any jurisdiction, including declarations, statements of
6 use, and/or statements of intent to use (e.g. Defs' Req. for Prod. No. 98). I
7 have reviewed or overseen the review of all documents produced by Plaintiff
8 during discovery and, based on my review, found that Plaintiff has produced
9 no evidence of ownership of any trademark comprising or containing the
10 Disputed Smiley registered under United States federal or state law.

11 ii. The creation and ownership of the Registered Work and
12 Disputed Smiley (Defs' Req. for Prod. Nos. 42, 55, 56, 67, 96), including
13 the identity of any persons with first-hand knowledge of same (Defs' Req.
14 for Admission Nos. 15-19). I have reviewed or overseen the review of all
15 documents produced by Plaintiff during discovery and, based on my review,
16 found that Plaintiff has produced no evidence that the Registered Work or
17 Disputed Smiley was created by Kurt Cobain.

18 iii. The registration of the Registered Work at issue, including all
19 documents concerning, attempting, or purporting to change, supplement,
20 correct, amplify and/or augment registrations covering the copyrighted work
21 alleged in the Complaint (Defs' Req. for Prod. Nos. 62-63, 65-66, 80). I
22 have reviewed or overseen the review of all documents produced by Plaintiff
23 during discovery and, based on my review, found that Plaintiff has produced
24 no evidence of any supplemental registration to correct the errors in the '166
25 Registration by misnaming the author as Nirvana, Inc.

26 iv. Any evidence that the Disputed Mark is inherently distinctive
27 or has acquired distinctiveness, including market study, consumer survey, or
28

1 similar analysis (formal or informal) directed at evaluating consumer
2 recognition and/or perception of the Disputed Mark (e.g. Defs' Req. for
3 Prod. Nos. 35-36, 101-103). I have reviewed or overseen the review of all
4 documents produced by Plaintiff during discovery and, based on my review,
5 found that Plaintiff has failed to produce any consumer survey or similar
6 analysis evaluating consumer recognition and/or perception of the Disputed
7 Mark.

8 v. The goods offered in connection with the Disputed Mark,
9 including sales (e.g. Defs' Req. for Prod. Nos. 106-107, 114). I have
10 reviewed or overseen the review of all documents produced by Plaintiff
11 during discovery and, based on my review, found that Plaintiff has produced
12 no competent documentary evidence that Plaintiff was offering socks
13 bearing the Disputed Smiley in the United States at the time MJI entered the
14 market.

15 vi. Any instance in which a Person has, claims to have, or whom
16 You believe has been or may have been confused, mistaken, and/or deceived
17 as to the affiliation, association, or other connection between Plaintiff and
18 Defendants, and/or as to the source or sponsorship of goods or services
19 originating with the Plaintiff or with Defendants, including the confusion
20 alleged in Paragraphs 30, 35, and 39 of the Complaint (e.g. Defs' Req. for
21 Prod. Nos. 37, 121, 122). I have reviewed or overseen the review of all
22 documents produced by Plaintiff during discovery and, based on my review,
23 found that Plaintiff has failed to produce any evidence of consumer
24 confusion.

25 vii. Efforts or actions considered or actually undertaken to enforce
26 rights in any intellectual property allegedly owned by Plaintiff, including the
27 Disputed Smiley (e.g. Defs' Req. for Prod. No. 128). I have reviewed or
28

1 overseen the review of all documents produced by Plaintiff during discovery
 2 and, based on my review, found that Plaintiff has not produced any
 3 documents of efforts to enforce its purported intellectual property as against
 4 third party uses Plaintiff's Rule 30(b)(6) witnesses were made aware of
 5 during depositions.

6 viii. Use of the Disputed Smiley standing alone, without reference to
 7 the term "NIRVANA", in connection with the marketing, advertising,
 8 promotion, offering, sale, and/or distribution of any good or service. I have
 9 reviewed or overseen the review of all documents produced by Plaintiff
 10 during discovery and, based on my review, found that Plaintiff has not (i)
 11 produced any documents nor offered any testimony, sufficient to distinguish
 12 sales of goods bearing the Disputed Smiley conjoined with the term
 13 "NIRVANA" from sales of products bearing the Disputed Smiley standing
 14 alone (if any); (ii) produced any documents evidencing "look for"
 15 advertising depicting the Disputed Smiley; or (iii) produced any
 16 documentary evidence of the value of a license to use the Disputed Smiley
 17 standing alone, divorced from the term NIRVANA, or that the Disputed
 18 Smiley is treated as a discrete trademark asset for licensing purposes.

19 ix. Plans, efforts, or actions considered or undertaken by Plaintiff
 20 in connection with expanding the use of the Disputed Smiley to goods or
 21 services not presently offered in connection with the Disputed Smiley (e.g.
 22 Defs' Req. for Prod. No. 119). I have reviewed or overseen the review of all
 23 documents produced by Plaintiff during discovery and, based on my review,
 24 found that Plaintiff has not produced any evidence of expanding the use of
 25 the Disputed Smiley on luxury products, including women's ready-to-wear
 26 apparel.

1 I declare under penalty of perjury under the laws of the United States that the
2 foregoing is true and correct.

3
4
5
6 DATED: November 2, 2020

By

/s/ Michael J. Zinna

Michael J. Zinna